THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIRA TANAKA, HISASHI SAWADA, and YUJI KOJIMA

Appeal No. 1996-1626
Application No. 07/642,848

ON BRIEF

Before HAIRSTON, JERRY SMITH and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of Claims 1, 3, and 5-10.

We reverse.

BACKGROUND

The invention is directed to an optical disk formed of a plastic disk body containing polycarbonate resin and an organic fluorescent coloring material. Claim 1 is reproduced below.

1. An optical disk subject to scanning by a laser beam for regenerating data stored in the form of pits in the optical disk and comprising:

a plastic disk body having opposing first and second surfaces, wherein data is stored in the form of pits in said first surface and said second surface is disposed to receive the laser beam;

a reflecting layer formed on said first surface, having said pits, of said plastic disk body;

a protecting layer covering said reflecting layer; and

said plastic disk body being formed of a material consisting essentially of polycarbonate resin and an organic fluorescent coloring material, said organic fluorescent coloring material being in an amount establishing a concentration in the range of from 0.005 to 1.000 weight percent of the material and being dispersed homogeneously in said plastic disk body and, further, having a light absorption characteristic of absorbing light of a wavelength shorter than the wavelength of a selected color within the visible light spectrum and of not absorbing light of a wavelength longer than that of the selected color, the laser beam having a wavelength near, but not within, the visible light spectrum.

The examiner relies on the following reference[1]:

EPO Patent Publication 311,512 (EPO ‘512), published April 12, 1989

Claims 1, 3, and 5-10 stand rejected under 35 U.S.C. § 103 over EPO ‘512.

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[1]The examiner has withdrawn a rejection based on an article published between appellants’ foreign priority date and U.S. filing date. See “Second Supplemental Examiner’s Answer,” mailed January 27, 1997 (Paper No. 40).

We refer to the Final Rejection (Paper No. 20), the Examiner's Answer (Paper No. 31), the Supplemental Examiner's Answer (Paper No. 34), and the Second Supplemental Examiner's Answer (Paper No. 40) for a statement of the examiner's position and to the Brief (Paper No. 30), the Reply Brief (Paper No. 33), the Supplemental Reply Brief (Paper No. 41), and the Second Supplemental Reply Brief (Paper No. 43) for appellants' position.

OPINION

The examiner contends that EPO '512 discloses an optical disk having a plastic body "consisting essentially of" polycarbonate and fluorescent coloring material. (Answer, page 3.) Although "pits" as claimed are not disclosed by the reference, the examiner takes notice that pits were well known "for address signal and/or synchronizing signal." (Id. at 3-4.) The examiner further contends that arriving at the claimed weight percent of the coloring material, and optimizing for an acceptable bit error rate (in respect to appellants' Claims 9 and 10) would have been routine in the art. (Id. at 4-5.) The examiner concludes that the subject matter as a whole would have been obvious to a person having ordinary skill in the art at the time the invention was made.

Appellants submit two separate arguments in rebuttal: (1) EPO '512 does not disclose or suggest an optical disk having a fluorescent dye; and (2) the language in independent claims 1 and 10, setting forth that the disk body is formed of a material "consisting essentially of" polycarbonate resin

and an organic fluorescent coloring material, patentably distinguishes over the reference. (See Brief, pages 6-9.)

We agree with appellants that the reference does not disclose or suggest an optical disk body having an organic fluorescent coloring material. EPO '512 discloses, in Figure 8, an optical disk with a transparent substrate formed of a molded resin. Page 2, lines 32-33 states that the resin molded body of the invention can be used for "optical parts," including the "transparent substrate of an optical disk." On page 3, line 26 through page 4, line 49 the reference describes a "first embodiment." The embodiment includes adding an organic fluorescent dye to a resin molded body "constituting the core of an optical fiber," and with the addition of the dye "it becomes possible to make light incident from the side face of the optical fiber." EPO '512, page 4, lines 5-9 and Figure 3. The reference then states that "an organic fluorescent dye as mentioned above can be added to the cladding material according to need" (page 4, lines 48-49).

A second application of the fluorescent dye is described on page 4, lines 50-57 and depicted in Figures 7a and 7b. A display is comprised of a light source 4 and a resin molded body containing an organic fluorescent dye 5 "absorbing light from the light source 4 and isotropically transmitting the light."

Thus, the fluorescent dye is taught as advantageous for the optical fiber of the reference, and for use in a lighted display, with no mention of any indication for use in the substrate of an optical disk. Claims 1 and 8-10 of the publication are consistent with our interpretation of the detailed description;

the "dye" and the "substrate of an optical disk" are claimed separately. Appellants refer (Brief, pages 6-7) to "the Declaration Pursuant to 37 CFR §1.132" as support for the argument that the artisan would not have interpreted the reference as suggesting an optical disk having a fluorescent dye. Appellants filed a declaration on July 25, 1994 (Paper No. 22) setting forth the opinion of the co-inventors of the instant application. On pages 2 through 13 of the declaration, appellants submit a reasonable case in support of their position, based on objective facts in the reference and allegations concerning what the artisan would have known. The examiner bears initial responsibility for determining whether affidavits or declarations submitted under 37 CFR § 1.132 are responsive to a rejection and present sufficient facts to overcome the rejection. See Manual of Patent Examining Procedure § 716, Seventh Edition. However, the examiner does not appear to respond to the substance of the declaration in any of the Final Rejection, Answer, or two supplemental Answers.[2]

In the examiner's responses to appellants' arguments, it appears that the examiner bases the opinion that the reference would have suggested an optical disk having a fluorescent dye principally on the reference's statement that the disclosed "resin molded body" can be used for optical parts such as a transparent substrate of an optical disk, and that the reference's Claim 10 is directed to a "resin molded

[2] In the Final Rejection, page 2, the examiner refers to an unexecuted paper filed November 29, 1993 and states that the declaration has not been considered because it is not signed by the inventors. There is no indication from the examiner that the declaration filed July 25, 1994 was considered untimely and thus not considered. To the contrary, the examiner states at the top of page 2 of the Answer that the amendment after final filed on July 25, 1994 has been entered.

body for optical parts" incorporating a "perylene or naphtalimide type dye." We do not find that the general statement in the reference's Summary of the Invention (Page 2), or the language of the broadly drafted claims, would have suggested to the artisan an optical disk having a fluorescent coloring material, upon consideration of the disclosure in its entirety. As we have pointed out supra, the fluorescent dye is disclosed as having useful applications which are limited to the particulars of optical fibers and lighted displays.

> It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

In re Hedges, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986), quoting In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965). The examiner has failed to deal with the portions of the reference which indicate that the fluorescent dye is useful for applications that appear to be irrelevant with respect to optical disk requirements.

Since we are in agreement with appellants' first argument, and conclude that a prima facie case of obviousness has not been established, we do not reach consideration of the second argument, which is based on the claim language "consisting essentially of."

CONCLUSION

The rejection of Claims 1, 3, and 5-10 is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
	)	BOARD OF PATENT
JERRY SMITH Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)	

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